

Notice of Allowability

Application No.

10/009,317

Examiner

Anand U. Desai, Ph.D.

Applicant(s)

SELSTED ET AL.

Art Unit

1656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to September 24, 2007 and October 12, 2007.
2. ☒ The allowed claim(s) is/are 15, 16, 18-20, 22, 33-35, 51-67, 84-103, 106, and 109.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____. |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

DETAILED ACTION

1. This office action is in response to Amendments filed on September 24, 2007 and October 12, 2007. Claims 55-67, and 91-103 have been withdrawn previously. Claims 15-22, 33-35, 51-54, 84-90, 106, and 109 are currently pending and are under examination.

Election/Restrictions

2. Claims 15, and 19 are allowable. The restriction requirement between the groups encompassing the withdrawn claims 55-67, and 91-103, as set forth in the Office action mailed on May 5, 2004, has been reconsidered in view of the allowability of claims to the elected invention pursuant to MPEP § 821.04(a). **The restriction requirement is hereby withdrawn as to any claim that requires all the limitations of an allowable claim.** Claims 55-67, and 91-103, directed to methods are no longer withdrawn from consideration because the claim(s) requires all the limitations of an allowable claim.

In view of the above noted withdrawal of the restriction requirement, applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Withdrawal of Rejections

3. The rejection of claims 51-54, and 87-90 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 36, and 37 of U.S. Patent No. 6,890,537 B2 is withdrawn based on the filing of a terminal disclaimer.
4. The rejection of claims 15-22, 33-35, and 84-86 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, and 23-25 of U.S. Patent No. 6,335,318 B1 is withdrawn based on the filing of a terminal disclaimer.
5. The rejection of claims 106, and 109 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 12 of U.S. Patent No. 6,514,727 B1 is withdrawn based on the filing of a terminal disclaimer.

EXAMINER'S AMENDMENT

6. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Dr. Deborah L. Cadena on December 7, 2007.

Examiner's amendment to the claims:

16. (Currently Amended) The isolated theta defensin of claim 15, wherein the amino-terminus of Gly at position 1 is linked through a peptide bond to the carboxy-terminus of Arg at position 18.

17. (Cancelled).

20. (Currently Amended) The isolated theta defensin of claim 19, wherein the amino-terminus of Gly at position 1 is linked through a peptide bond to the carboxy-terminus of Arg at position 18.

21. (Cancelled).

65. (Currently Amended) The method of claim 64 ~~54~~, wherein said administration is topical.

66. (Currently Amended) The method of claim 64 ~~54~~, wherein said administration is by injection.

67. (Currently Amended) The method of claim 64 ~~54~~, wherein said administration is oral.

106. (Currently Amended) A method of expressing a theta defensin, comprising

- (a) transforming an isolated host cell with a vector ~~administering a vector to a~~ cell, wherein said vector comprises an expression element operationally linked to a nucleotide sequence encoding the theta defensin peptide of claim 15; and
- (b) expressing said encoded theta defensin ~~peptides~~ peptide, wherein said ~~peptides~~ peptide forms a theta defensin.

109. (Currently Amended) A method of expressing a theta defensin, comprising

- (a) transforming an isolated host cell with a vector ~~administering a vector to a~~ cell, wherein said vector comprises an expression element operationally linked to a nucleotide sequence encoding the theta defensin peptide of claim 19; and
- (b) expressing said encoded theta defensin ~~peptides~~ peptide, wherein said ~~peptides~~ peptide forms a theta defensin.

Allowable Subject Matter

7. Claims 15, 16, 18-20, 22, 33-35, 51-67, 84-103, 106, and 109 are allowed.
8. The following is an examiner's statement of reasons for allowance: The prior art does not disclose the theta defensins currently identified by SEQ ID NO: 32 and SEQ ID NO: 33. The prior art describes theta defensins as antimicrobial peptides (see for example U.S. Patent 6,890,537 B2).

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anand U. Desai, Ph.D. whose telephone number is (571) 272-0947. The examiner can normally be reached on Monday - Friday 9:00 a.m. - 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Kathleen Kerr Bragdon can be reached on (517) 272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:
10/009,317
Art Unit: 1656

Page 6

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

December 7, 2007

AD
/Anand Desai/
Patent Examiner
Art Unit 1656

ROBERT MONDESI
PRIMARY EXAMINER

Robert B. Mondesi
12-10-07